

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-7 and 9-11 remain pending in the Application. Claims 8, 12-22 have been cancelled. Applicants have amended claim 1 to recite, “wherein the first and second nucleic acid affinity matrices provides each a different multiplicity of nucleic acid probes, hybridizes with two different set of nucleic acids, and eludes the selected first and second set of nucleic acids from the first and second matrices; Labeling the selected first and second sets of nucleic acids with different labels; and Detecting the selected first and second sets of nucleic acids based upon the different labels.” The support for the new claims can be found, e.g., on page 3, lines 18 – 25, on page 27, lines 11-13 and in Figure 1 and Figure 2. Applicants assert that no new matter is presented by these amendments and respectfully request entry of the same.

Rejections under 35 U.S.C. § 112 is obviated.

Claims 1-7 and 9-11 are rejected under 35 U.S.C. §112 second paragraph, as allegedly being indefinite. The applicants respectfully disagree.

However, for the purpose of expediting the issuances of claims, Applicants have amended the claims to more particularly point out distinctly claim the subject matter. “wherein the first and second nucleic acid affinity matrices provides each a different multiplicity of nucleic acid probes, hybridizes with two different set of nucleic acids, and eludes the selected first and second set of nucleic acids from the first and second matrices; Labeling the selected first and second sets of nucleic acids with different labels; and Detecting the selected first and second sets of nucleic acids based upon the different labels.” The support for the new claims can be found, e.g., on page 3, lines 18 – 25, on page 27, lines 11-13 and in Figure 1 and Figure 2. Applicants respectfully submit that this rejection is obviated by the amendments. Applicants reserve the rights to pursue the original claims in a related application.

Examiner states that “The claim fails to clearly state the steps of the methods and the relationships among the different steps. For example, the step of “labeling of the first and second set of nucleic acids with different labels” could be carried out before the hybridization step. It is not clear how the first and second sets of nucleic acids are differentially labeled before the hybridization step.”

The applicants respectfully points out that the step of the “Labeling the selected first and second sets of nucleic acids with different labels” can be carried out before the “Detecting the selected first and second sets of nucleic acids based upon the different labels,” where the detection step comprises hybridizing as stated in claim 18.

Examiner states that “The claimed method (as recited in Claim 1) requires detecting and or distinguishing the “first” and the “second” set of nucleic acids by labeling the different sets of nucleic acids. However, the claimed method also requires a selection step of the two different sets of nucleic acids before the labeling step. It is not clear how the different steps are connected, and the order of the steps that is required to carry out the claimed method.

Based on the amended claim 1, it is clear that the selection step of the two different sets of nucleic acids is before the labeling step of the “selected” first and second set of nucleic acids. In addition, there are examples of the method for analyzing a nucleic acid sample as described in claim 1. The specification, for example, page 32, lines 13-20, of the application discloses examples of the steps described in claim 1. Withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 102 is obviated.

Claim 1-7 and 9-11 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Fodor et al (USP 5,800,992; 09/01/1998)). Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Fodor et al (USP 6,309,822). Claims 1-7 and 9-11 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Fodor et al (USP 6,576,424). Claims 1, 2, 4-7, 9 and 10 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Fodor et al (USP 6,551,784). Applicant respectfully disagrees with the Examiner.

However, for the purpose of expediting the issuance of claims, Applicants have amended the claims to more particularly point out distinctly claim the subject matter. “wherein the first and second nucleic acid affinity matrices provides each a different multiplicity of nucleic acid probes, hybridizes with two different set of nucleic acids, and eludes the selected first and second set of nucleic acids from the first and second matrices; Labeling the selected first and second sets of nucleic acids with different labels, and Detecting the selected first and second sets of nucleic acids based upon the different

labels.” The support for the new claims can be found, e.g., on page 3, lines 18 – 25, on page 27, lines 11-13 and in Figure 1 and Figure 2. Applicants reserve the rights to pursue the original claims in a related application. Withdrawal of these rejections is respectfully requested.

Rejections under 35 U.S.C. § 103 is obviated.

Claims 1-7 and 9-11 are rejected under 103(a) as allegedly being unpatentable over Lichtenwalter (USP 5,683,875) in view of Fodor et al (USP 5,800, 992). Applicant respectfully disagrees with the Examiner.

However, for the purpose of expediting the issuance of claims, Applicants have amended the claims to more particularly point out distinctly claim the subject matter. “wherein the first and second nucleic acid affinity matrices provides each a different multiplicity of nucleic acid probes, hybridizes with two different set of nucleic acids, and eludes the selected first and second set of nucleic acids from the first and second matrices; Labeling the selected first and second sets of nucleic acids with different labels; and Detecting the selected first and second sets of nucleic acids based upon the different labels.” The support for the new claims can be found, e.g., on page 3, lines 18 – 25, on page 27, lines 11-13 and in Figure 1 and Figure 2. Applicants reserve the rights to pursue the original claims in a related application. Withdrawal of these rejections is respectfully requested.

Nonstatutory Double Patenting is Obviated

On pages 10 - 14 of the Office Action, dated 12/16/2005, the Examiner has rejected the following claims under the judicially created doctrine of obviousness-type double patenting:

Claims 1-7 and 9-11 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,800,992.

Claims 1, 2 and 4-7 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,309,822.

Claims 1-7 and 9-11 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 16, 17 and 39-64 of U.S. Patent No. 6,576,424.

Claims 1, 2, and 4-7 are rejected on the ground of non statutory obviousness-type double patenting as being unpatentable over claims 1-11 and 20 of U.S. Patent No. 6,551,784.

Applicants file, herewith a terminal disclaimer in conjunction with above U.S. Patent Nos. Therefore, Applicants believe that the double patenting rejection is obviated.

CONCLUSION

For these reasons, Applicants believe all pending claims are now in condition for allowance. If the Examiner has any questions pertaining to this application or feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at (408) 731-5000.

The Commissioner is hereby authorized to charge any additional fees during the pendency of this application including fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required, included any required extension of time fees, or credit any overpayment to Deposit Account 01-0431. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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